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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/277,172	03/26/1999	TORU MAEDA	35G2368	3148
5514	7590	10/04/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			POKRZYWA, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/277,172	MAEDA, TORU	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 July 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 66-68,70-74 and 89-96 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 92-96 is/are allowed.
- 6) Claim(s) 66-68 and 89-91 is/are rejected.
- 7) Claim(s) 70-74 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's amendment was received on 7/11/05, and has been entered and made of record. Currently, claims 66-68, 70-74, and 89-96 are pending.

***Response to Arguments***

2. Applicant's arguments, see pages 15-25, filed 7/11/05, with respect to the rejection(s) of the now amended claim(s) 66 and 89, which were previously rejected under 35 U.S.C.103 as being unpatentable over Williams et al. (U.S. Patent Number 6,192,045) in view of Merritt et al. (U.S. Patent Number 6,421,429), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Yamada (U.S. Patent Number 5,521,719), which was cited in the Office action dated 7/30/02, and can now be interpreted as teaching independent claims 66 and 89, as well as new independent claim 91, as currently written.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 66-68, and 89-91** are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada (U.S. Patent Number 5,521,719, cited in the Office action dated 7/30/02).

Regarding *claim 66*, Yamada discloses an image communication method that utilizes a plurality of Internet facsimile modes and a G3 facsimile mode (column 19, lines 42-60, being functions defined by the subaddresses, as seen in Figs. 11-13), with the method comprising the steps of detecting an Internet facsimile mode (see Figs. 11-13), which a destination apparatus of image data has, from the plurality of Internet facsimile modes during communication in the facsimile mode, in accordance with a first procedure signal of the G3 facsimile mode from the destination apparatus (see Figs. 3 and 14, step S4-S7, column 7, line 63-column 9, line 14, and column 18, lines 47-58), selecting an Internet facsimile mode for communicating with the destination apparatus from the plurality of Internet facsimile modes based on the detected Internet facsimile mode (column 18, line 47-column 19, line 60), directing the destination apparatus to switch to the selected Internet facsimile mode (column 18, lines 51-58), and transmitting an image to the destination apparatus based on the Internet facsimile mode of the destination apparatus detected in the detecting step (column 18, line 47-column 19, line 60).

Regarding *claim 67*, Yamada discloses the method discussed above in claim 66, and further teaches that the detected Internet facsimile mode of the destination apparatus is stored

(column 14, line 52-column 15, line 25), wherein image data is transmitted in accordance with the stored Internet facsimile mode of the destination apparatus (column 15, lines 5-53, and column 19, lines 1-60).

Regarding *claim 68*, Yamada discloses the method discussed above in claim 67, and further teaches that the step of determining whether or not the communication is a first communication operation with the destination apparatus in the Internet facsimile mode (column 3, line 55-column 4, line 49, and column 14, line 63-column 15, line 25), wherein image data is transmitted in the G3 facsimile mode in a first communication operation (column 15, lines 5-53), based on determination that the communication is a first communication operation (column 14, line 63-column 15, line 25), and wherein image data is transmitted in the Internet facsimile mode of the destination (column 15, lines 8-25, and column 16, lines 16-33), based on determination that the communication is not a first communication operation (column 16, line 1 through column 17, line 52).

Regarding *claim 89*, Yamada discloses an image communication apparatus that utilizes a plurality of Internet facsimile modes and a G3 facsimile mode (column 19, lines 42-60, being functions defined by the subaddresses, as seen in Figs. 11-13), with the apparatus comprising a detection unit adapted to detect an Internet facsimile mode (see Figs. 11-13), which a destination apparatus of image data has, from the plurality of Internet facsimile modes during communication in the facsimile mode, in accordance with a first procedure signal of the G3 facsimile mode from the destination apparatus (see Figs. 3 and 14, step S4-S7, column 7, line 63-column 9, line 14, and column 18, lines 47-58), a selection unit adapted to select an Internet facsimile mode for communicating with the destination apparatus based on the Internet facsimile

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mode detected by the detection unit (column 18, line 47-column 19, line 60), a direction unit adapted to direct the destination apparatus to switch to the Internet facsimile mode selected by the selection unit (column 18, lines 51-58), and a transmission unit adapted to transmit an image based on the Internet facsimile mode selected by the selection unit (column 18, line 47-column 19, line 60).

Regarding *claim 90*, Yamada discloses the method discussed above in claim 66, and further teaches of determining an address of the Internet facsimile mode of the destination apparatus in accordance with a second procedure signal of the G3 facsimile mode (see Figs. 11-13, and column 18, line 47-column 19, line 60).

Regarding *claim 91*, Yamada discloses an image communication method that utilizes an Internet facsimile mode and a G3 facsimile mode (column 19, lines 42-60), the method comprising the steps of determining an Internet facsimile function (being functions defined by the subaddresses, as seen in Figs. 11-13) of a destination apparatus based on a G3 signal transmitted from the destination apparatus during communication in the G3 facsimile mode (see Figs. 3 and 14, step S4-S7, column 7, line 63-column 9, line 14, and column 18, lines 47-58), directing the destination apparatus to switch to an Internet facsimile mode in accordance with a determination in the determining step (column 18, lines 51-58), and transmitting an image to the destination apparatus by switching to the Internet facsimile mode in accordance with the response to the direction of the directing step (column 18, line 47-column 19, line 60).

***Allowable Subject Matter***

5. **Claims 92-96** are allowed.
6. **Claims 70-74** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claim 70**, in the examiner's opinion, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have the method, as claimed, include the features of selecting the Internet facsimile mode, being one of a simple mode, a full mode, and a real time mode , according to a predetermined priority, and performing the selected Internet facsimile mode.

Regarding **claims 92 and 96**, in the examiner's opinion, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have the method and apparatus, as claimed, include the features of communicating in the Internet facsimile mode in accordance with a specific condition, when it is determined that the destination apparatus designated by a user has the Internet facsimile function and the memory does not memorize the receiving capacity of the Internet facsimile function of the destination apparatus based on information memorized in the memory.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa  
Primary Examiner  
Art Unit 2622

jrp

